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James P. Broder Roeder & Broder LLP 9915 Mira Mesa Blvd. Suite 300 San Diego, CA 92131			EXAMINER RIVERA, WILLIAM ARAUZ	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/930,120	<b>Applicant(s)</b> HANSCOM, KEN	
	<b>Examiner</b> William A. Rivera	<b>Art Unit</b> 3654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-29, 34 and 36-38 is/are allowed.
- 6) ☒ Claim(s) 1-13, 30-33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show/label “groove depth 78” in Figure 4 as described in the specification on Page 13, line 6. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case there is no support for the phrase "the groove having a groove length *in a direction substantially along the circumference, and a groove bottom that is substantially linear in a direction along the groove length*".

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

Claims 1-13 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-13 and 35 are rejected for the reasons set forth in above under 35 USC § 112, 1<sup>st</sup> Paragraph.

Claim 11 is vague and indefinite. The term "*the grooves*" has no antecedent basis in the claim. Note that Claim 1 only sets forth "*a groove*".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Daly (U.S. Patent No. 5,199,168).

With respect to Claims 1, 10, and 13, Daly, Figures 1-7, teaches a guide assembly, the guide assembly comprising: a rotatable first roller 20,R including a perimeter surface, a circumference, a longitudinal axis and a groove 52,54 disposed into the perimeter surface, the groove having a groove length in a direction along the circumference, and a groove bottom that is substantially linear in a direction along the groove length; including a roller mount wherein the roller is rotatably mounted on the roller mount approximately on at least a portion of the longitudinal axis; a tape drive including the guide assembly, a take-up 14 and a head assembly 12.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 12, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly (U.S. Patent No. 5,199,168) as applied to Claims 1, 10, and 13 above and further in view of Sawano et al (Japanese Patent No. 10-106074).

With respect to Claims 2-4 and 12, Daly is advance above. Daly teaches all the elements of the guide roller except for a groove having a groove length less than the circumference. However, Sawano et al, Figures 1-3, teach a guide with a plurality of spaced apart grooves, each of the grooves having a groove length that is less than the circumference; wherein the grooves are aligned substantially parallel to the circumference; the grooves are semi-randomly distributed on the perimeter surface. It would have been obvious to one of ordinary skill in the art to

Art Unit: 3654

provide Daly with a groove on the guide roller, as taught by Sawano et al, for the purpose of controlling dynamic air entrainment between the roller surface and the magnetic tape as well as minimizing the friction between the tape and the guide roller.

With respect to Claims 30-32, the method described in these claims would inherently result from the use of the tape drive with guide rollers of Daly in view of Sawano et al as advanced above.

Claims 5-9, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly in view of Sawano et al as applied to claims 1-4, 10, 12-13, 26-27, 30-32 above.

With respect to Claims 5-9, 33, and 35, Daly in view of Sawano et al are advanced above. Daly in view of Sawano et al do not mention the particular dimensions of the grooves. However, it would have been obvious to one of ordinary skill in the art, as determined through routine experimentation and optimization, to dimension the grooves of Daly in view of Sawano et al as specified in Claims 5-9, 11, 33, and 35 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Claims 5-9, 11-12, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hikita as applied to claims 1-4 and 10 above or Hikita as applied to claims 1-4, 10, 14-15, 20-21 and 26-27 above.

With respect to Claims 5-9, 11, and 35, Daly in view of Sawano are advanced above. Daly in view of Sawano do not mention the particular dimensions of the grooves. However, it would have been obvious to one of ordinary skill in the art, as determined through routine experimentation and optimization, to dimension the grooves of Daly in view of Sawano as

specified in Claims 5-9, 11, and 35 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

***Allowable Subject Matter***

Claims 14-29, 34, and 36-38 are allowed.

The following is an examiner's statement of reasons for allowance:

Claims 14-29, 34, and 36-38 are allowable over the prior art of record because the prior art of record does not teach or suggest the entire combination of elements of the guide assembly set forth including a roller including a perimeter surface, a circumference, and a plurality of discontinuous grooves disposed into the perimeter surface, one of the grooves having a groove depth that varies in a direction along a length of the groove. None of the references of the prior art teach or suggest a roller having a groove with a groove depth that varies in a direction along a length of the groove as advanced above and such do not provide the necessary motivation, absent applicant's specification, for modifying the guide roller in the manner required by the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

Applicant's arguments filed April 10, 2007 have been fully considered but they are not persuasive.

With respect to applicant's remarks on Page 10 regarding the Daly reference, it is applicant's position that Daly is directed to a tachometer and that groove 50 is spiral shaped. In

Art Unit: 3654

the instant case it should be noted that applicant is merely claiming a guide assembly with a groove length along the circumference. Figure 1 clearly shows tape 20 being guided along guide R6. Further, since applicant only claims one groove length, Figure 3, shows a groove length 52 or 54 in a direction substantially along the circumference. There are no limitations set forth in the claim to preclude the spiral grooves 50.

With respect to applicant's remarks regarding the combination of Daly in view of Sawano, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would have been motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated in the primary reference. The test for combining references is what the combination of disclosures taken as a whole would have suggested to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is 571-272-6953. The examiner can normally be reached on Monday to Friday - 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Q. Nguyen can be reached on 571-272-6952. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William A Rivera/  
Primary Examiner, Art Unit 3654

May 25, 2009